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REMARKS

This responds to the Office Action mailed on <u>September 22, 2006</u>.

Claims 18, 24, 31, 48 and 54 are amended, no claims are canceled, and no claims are added; as a result, claims 1-62 are now pending in this application.

Drawing Objections

The drawings were objected to for informalities in Figures 5 and 7C.

Applicants have amended Figure 5 by adding a label 84 for a list user interface as disclosed on page 18 of the specification, and have also amended Figure 7C by showing a block 172 as disclosed on page 27, paragraph 55 of the specification. Applicants believe that such amendment of Figures 5 and 7C overcomes the objection of drawings.

Specification Objections

The specification was objected to for informalities in paragraph [0038].

Applicants have amended paragraph 38 of the specification as suggested by the Office Action, thus believe that such amendment of the specification overcomes the objection of specification.

Claim Objections

Claims 18, 31 and 48 were objected to for informalities.

Applicants have amended claims 18, 31 and 48 as suggested by the Office Action, thus believe that such amendment of these claims overcomes the objection of these claims.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on September 25, 2001. Applicants respectfully request that initialed copies of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

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§112 Rejection of the Claims

Claims 18, 24, 48 and 54 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Applicants have amended claims 18, 24, 48 and 54, and believe such amendment of these claims overcomes the indefiniteness rejection of these claims under 35 U.S.C. § 112, second paragraph.

§102 Rejection of the Claims

Claims 1-2, 6-17, 19, 21-32, 36-47, 49, and 51-62 were rejected under 35 U.S.C. § 102(e) for anticipation by Gillman (U.S. Publication No. 2002/0147674). Applicants reserve the right to swear behind this reference at a later date. Applicants respectfully traverse this rejection for the reasons stated below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent claim 1 recites:

1.   A method to facilitate a transaction via a network-based transaction
facility, the method including:
        recording a pre-order relating to an item at the transaction facility, the pre-
order specifying a plurality of pre-order attributes;
        receiving an offer to sell the item at the transaction facility, the offer
specifying a plurality of offer attributes;
        **automatically performing a matching operation to detect a
correspondence between the pre-order and the offer, the matching operation
utilizing at least one pre-order attribute of the plurality of pre-order
attributes and at least one offer attribute of the offer attributes to detect the
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> **responsive to a detection of the correspondence by the matching operation, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item.**
> (Emphasis added)

Gillman is directed to "systems and methods for dynamically matching, in a networked environment, a person or business entity requesting a specialized product (such as a metal forging) with a person or business entity capable of providing that product." See para [0010]. "The electronic buying system is buyer-driven. Generally speaking, the auction in which an auction process begins when a registered buyer describes a good or service which it wishes to procure by filling out an electronic RFQ (Request For Quote) form." See para [0030]. "A supplier responds to a buyer's RFQ by inputting various information about its proposed supply of the requested forging. Specifically, suppliers will generally provide a price and delivery date as well as any additional terms and conditions the supplier desires to add to the deal." See para [0041]. "As the auction progresses (until closing), the various invited suppliers preferably bid on providing the requested good or service." See para [0042].

It can be seen clearly that a buyer of Gillman submits an electronic request (RFQ) for a good or service, and suppliers respond to the buyer's request to bid on the requested good or service. Gillman does not disclose, and does not need, a matching operation to detect a correspondence between the request from the buyer and the bids from the suppliers. Thus, Applicants submit that Gillman fails to disclose "automatically performing a matching operation **to detect a correspondence** between the pre-order and the offer, the matching operation utilizing at least one pre-order attribute of the plurality of pre-order attributes and at least one offer attribute of the offer attributes to detect the correspondence" (emphasis added) as recited in claim 1.

Applicants do note that Gillman does mention "electronically **matching** a buyer request in a good with an entity capable of providing said a good" (see Claim 1) and "systems and methods for **dynamically matching**, in a networked environment, a person or business entity requesting a specialized product (such as a metal forging) with a person or business entity capable of providing that product" (see para [0010]).

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However, Applicants contend that this is not an automated matching operation to detect a correspondence between a pre-order and an offer. Rather, the "match" that is contemplated by Gillman is as a result of a buyer choosing a winner of an auction from a number of suppliers. The Applicants draw the Examiner's attention to paragraphs 49 and 50 of Gilliam, and specifically to the following text, which clearly point out that the "match" contemplated by Gilliam is a manual selection by a buyer of a specific supplier:

" When a **buyer chooses the winner of the auction**, all of the suppliers are preferably given a notification that the buyer has made its selection and the identity of the winning supplier is revealed. These "losing" suppliers may then view the terms of the accepted bid and are put in a better position to bid on the next similar forging, or the next forging from that particular buyer. After the buyer makes its selection, the buyer and supplier preferably need to consummate the transaction outside of the parameters of the system. Preferably, the supplier then has to pay a commission to the system **for the match**. This commission may be approximately 3%, or some other discount over current industry practice. Failure to pay a commission may result in the supplier's dismissal from the site and/or other contractual penalties."
(Emphasis added) (Gillman, para. [50])

Applicants also noted that Gillman does describe a supplier registration process that allows an individual supplier to associate with a shop or shops. A supplier may conduct a search of the auction system to determine if someone from a supplier's shop has already registered with the system. Specifically, Gillman states the following:

" Additional supplier registration sections preferably allow the individual supplier to associate itself with a specific forge shop or shops. There may be a "SEARCH" dialog button that allows the supplier to conduct a search of the auction system to determine if someone from the supplier's shop has already registered with the system. If an individual from the supplier's forge shop has already registered with the system, that information

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will preferably be presented for verification and acceptance. The individual supplier will

then be associated with this forge shop on the system.

[0064] If no companies **match the search criteria**, then the supplier preferably will be

given the opportunity to: 1) register its "new" company; 2) attempt to search again; 3)

cancel the registration process; or 4) go back to the previous page to alter other

registration information. If the supplier elects to register a new company with the system,

the supplier may first be asked to enter a company name."

(Emphasis added) (Gillman, paras. [63] and [64])

Again, the match described in the above quoted paragraphs is clearly not an automatically

performed "matching operation **to detect a correspondence** between **the pre-order and the**

offer" (emphasis added),, as recited in claim 1 of the present application.

It follows that Gillman also fails to disclose "**responsive to a detection of the**

correspondence by the matching operation, automatically performing a transaction facilitating

operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the

offer to sell the item" (emphasis added) as recited in claim 1, because, as stated above, Gillman

does not disclose a matching operation to detect a correspondence between the request and the

bids.

Thus, Applicants submit that Gillman does not disclose each and every element of claim

1 as arranged in the claim, and accordingly Gillman does not anticipate claim 1.

Independent claims 31, 61 and 62 have similar elements as recited in independent claim

1. Thus the arguments presented above with respect to claim 1 also apply, at least in part, to

claims 31, 61 and 62. Accordingly, Applicants submit that Gillman does not anticipate claims

31, 61 and 62 either.

Claims 2, 6-17, 19, 21-24, 32, 36-47, 49, and 51-60, directly or indirectly, depend on

claims 1 or 31. Thus for at least the same reasons discussed for claims 1 or 31, Applicants

submit that Gillman does not anticipate these dependent claims either.

Independent claim 25 recites:

      25. A method to facilitate pre-ordering of an offering via a network-based
transaction facility, the method including:

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> **responsive to user identification of an offering, communicating offering information to a user regarding the offering**; and
>
> in conjunction with the offering information, communicating to the user a selectable option to pre-order the offering by specifying pre-order attribute information.
>
> (Emphasis added)

The Office Action asserts that para 30 and Figures 2-3 of Gillman disclose the features of claim 25. Applicants disagree. Referring to para 30 of Gillman,

"In a preferred embodiment of the present invention, the electronic buying system is buyer-driven. Generally speaking, **the auction process begins when a registered buyer describes a good and/or service which it wishes to procure by filling out an electronic RFQ (Request For Quote) submission form.** This form preferably prompts the user to provide certain information about the product (e.g., product type, description, specification, price, and delivery date), in this case a metal forging, to which interested suppliers may provide responses (preferably including counter-terms such as the supplier's suggested price, delivery date or schedule, and any other relevant terms and conditions for providing the product to the buyer)." (Emphasis added) (Gillman, para. [30])

Clearly, the above citation from Gillman discloses that a buyer initiates the auction process. However, claim 25 recites a method to facilitate pre-ordering of an offering, in which offering information (e.g., from a supplier) is communicated to a user (e.g., a buyer) in response to user identification of the offering, and in conjunction with the offering information, a selectable option is communicated to the user (e.g., the buyer) to pre-order the offering, thus the facilitating process of claim 25 is initiated by the supplier via the offering, but is not initiated by the buyer. Accordingly, para 30 of Gillman and claim 25 adopt different approaches. Applicants cannot find that Figures 2-3 disclose the above emphasized feature of claim 25. Thus, Applicants submit that Gillman does not anticipate claim 25.

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Claims 26-30, directly or indirectly, depend on claim 25. Thus, for at least the same reasons discussed for claim 25, Applicants submit Gillman does not anticipate these dependent claims either.

Therefore, Applicants respectfully request reconsideration and allowance of claims 1-2, 6-17, 19, 21-32, 36-47, 49, and 51-62.

§103 Rejection of the Claims

Claims 3-4 and 33-34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Gillman in view of Force (U.S. 6,704,716). Applicants reserve the right to swear behind these references at a later date.

Applicants traverse the §103 rejection of these claims and respectfully submit that the Office Action did not make out a *prima facie* case of obviousness, because even if combined, the cited references fail to teach or suggest all of the claim limitations of these claims.

Claims 3-4 and 33-34, directly or indirectly, depend on claims 1 or 31, thus includes all the elements of claims 1 or 31. For the reasons discussed previously, Applicants submit that Gillman fails to teach features "automatically performing a matching operation **to detect a correspondence** between the pre-order and the offer, the matching operation utilizing at least one pre-order attribute of the plurality of pre-order attributes and at least one offer attribute of the offer attributes to detect the correspondence" and "**responsive to a detection of the correspondence by the matching operation**, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item" (emphasis added) as included in claims 3-4 and 33-34.

Force recites a method and system for conducting an online transaction that allows a seller and a bidder to negotiate a final sale price, but Force fails to teach the above stated limitations as included in claims 3-4 and 33-34. Thus, even combined, Gilman and Force fail to teach or suggest all of the limitations of claims 3-4 and 33-34, thus do not render these claims obvious.

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Claims 5 and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Gillman in view of Godin (U.S. 5,890,138). Applicants reserve the right to swear behind these references at a later date. Applicants traverse the §103 rejection of these claims.

Claims 5 and 35 indirectly depend on claims 1 or 31, thus includes all the elements of claims 1 or 31. For the reasons discussed previously, Applicants submit that Gillman fails to teach features "automatically performing a matching operation **to detect a correspondence** between the pre-order and the offer, the matching operation utilizing at least one pre-order attribute of the plurality of pre-order attributes and at least one offer attribute of the offer attributes to detect the correspondence" and "**responsive to a detection of the correspondence by the matching operation**, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item" (emphasis added) as included in claims 5 and 35.

Godin recites an auction system which allows users to participate using their own computers suitably connected to the auction system, but Godin fails to teach the above stated limitations as included in claims 3-4 and 33-34. Thus, even combined, Gilman and Godin fail to teach or suggest all of the limitations of claims 5 and 35, thus do not render these claims obvious.

Claims 18 and 48 were rejected under 35 U.S.C. § 103(a) as unpatentable over Gillman in view of Pepin (U.S. Publication No. 2002/0042835). Applicants reserve the right to swear behind these references at a later date. Applicants traverse the §103 rejection of these claims.

Claims 18 and 48 indirectly depend on claims 1 or 31, thus includes all the elements of claims 1 or 31. For the reasons discussed previously, Applicants submit that Gillman fails to teach features "automatically performing a matching operation **to detect a correspondence** between the pre-order and the offer, the matching operation utilizing at least one pre-order attribute of the plurality of pre-order attributes and at least one offer attribute of the offer attributes to detect the correspondence" and "**responsive to a detection of the correspondence by the matching operation**, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item" (emphasis added) as included in claims 18 and 48.

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Pepin recites a system and method for processing information performs actions associated with rules to modify, adjust, calculate and massage data to comport with downstream handling requirements, but Pepin fails to teach the above stated limitations as included in claims 18 and 48. Thus, even combined, Gilman and Pepin fail to teach or suggest all of the limitations of claims 18 and 48, thus do not render these claims obvious.

Claims 20 and 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over Gillman in view of Fickes ("Waste Web"). Applicants reserve the right to swear behind these references at a later date. Applicants traverse the §103 rejection of these claims.

Claims 20 and 50, directly or indirectly, depend on claims 1 or 31, thus includes all the elements of claims 1 or 31. For the reasons discussed previously, Applicants submit that Gillman fails to teach features "automatically performing a matching operation **to detect a correspondence** between the pre-order and the offer, the matching operation utilizing at least one pre-order attribute of the plurality of pre-order attributes and at least one offer attribute of the offer attributes to detect the correspondence" and "**responsive to a detection of the correspondence by the matching operation**, automatically performing a transaction facilitating operation to facilitate establishment of a transaction whereby the pre-order is satisfied by the offer to sell the item" (emphasis added) as included in claims 20 and 50.

Applicants cannot find any part of Fickes that teaches the above stated limitations as included in claims 20 and 50. Thus, even combined, Gilman and Fickes fail to teach or suggest all of the limitations of claims 20 and 50, thus do not render these claims obvious.

Therefore, Applicants submit that the Office Action did not make out a *prima facie* case of obviousness of claims 3-5, 18, 20, 33-35, 48, and 50, and thus respectfully request reconsideration and allowance of these claims.

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<u>RESERVATION OF RIGHTS</u>

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at 612-373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

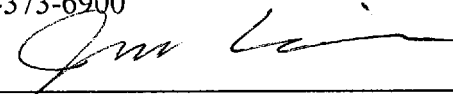Respectfully submitted,

MICHAEL SCHWANKL ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-373-6900

Date 7/10/2007

By _____
Jun Wei
Reg. No. 55,717

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Petitions, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of July 2007.

Name _____

Signature _____